

RESPONSE AND REMARKS

Amendments to original Claims 1-89 (renumbered as Claims 1-90) are filed concurrently herewith to more distinctly claim the invention, and/or, to correct numbering of the claims. Entry of the amendments, and reconsideration of the application, as amended, are respectfully requested.

In the Office Action, the Examiner formally confirmed a restriction requirement, construing originally numbered Claims 1-69 as Group I, and originally numbered Claims 70-89 as Group II. In Group I, the Examiner formally confirmed a restriction requirement, construing originally numbered Claims 8-12 and 39-42 as Species A; originally numbered Claims 22-25, and 52-55 as Species B.

Pursuant to the formal restriction requirement dated March 31, 2004 and in accordance with 35 U.S.C. 121 and 37 C.F.R. § 1.142, Applicant formally confirms election of, and hereby formally elects, for further examination the invention construed by the Examiner as Group I and Species A, described by the Examiner as originally numbered Claims 1-21, 26-51 (renumbered as Claims 26-52) and 56-69 (renumbered as Claims 57-70); Claims 22-25, 52-55 (renumbered as Claims 53-56), and 70-89 (renumbered as Claims 71-90) corresponding to non-elected Group II and non-elected Species B, are withdrawn from examination without prejudice to Applicant's filing in accordance with 35 U.S.C. §§ 120 and 121 and 37 C.F.R. § 1.142, during the pendency of the present Application, a divisional application directed to non-elected Group II construed by the Examiner as Claims 70-89 (renumbered as Claims 71-90) and/or a divisional application directed to non-elected Species B, construed by the Examiner as Claims 22-25, and Claims 52-55 (renumbered as Claims 53-56).

SPECIFICATION

In the Office action, the Examiner objected to use of various trademarks as used in the specification and indicated that the trademarks should be capitalized wherever they appear. Responsive to the Examiner's objections to the use of trademarks, the specification, as amended, identifies trademarks used

in the specification, references the proprietary nature of those trademarks through the use of the "TM" symbol, and equates the TM-designated trademark with both an all-capitalized version of the trademark and with alternative ways in which the trademarks appear in the specification.

CLAIM OBJECTIONS

In the Office Action, the Examiner objected to the numbering of the Claims, noting that there were two Claims originally numbered 42. The claim amendments filed concurrently herewith reflect the claim renumbering and claim dependency renumbering.

DOUBLE PATENTING

In the Office Action, the Examiner objected Claim 10, construing Claim 10 to be a duplicate of Claim 9; the Examiner also objected to Claim 41 as being a duplicate of Claim 40. The Examiner noted a "slight difference in wording" but found the claims to be duplicates.

It is respectfully submitted that the claims objected to by the Examiner are not duplicates because there is a patentable difference in claimed terms between Claims 9 and 10, and between Claims 40 and 41, as those claims have been amended herewith. Claims 9 and 40 are directed to "an onscreen display of a shipping label"; Claims 10 and 41 are directed, on the other hand, to "an onscreen display of a shipping document."

As the Examiner correctly notes, a shipping label could be considered to be a type of shipping document. However, even though it is possible that a shipping label may be considered to be a "shipping document", a shipping document may be different than, and may comprise more or less information than would be present on, a shipping label.

In some cases, information on a shipping label can be used to complete a shipping document, such as, for example, a shipping manifest document. See, e.g., Specification, page 60, lines 7-9 ("The purpose of the Shipping Mode is to print a shipping label or otherwise provide the information necessary to prepare a

shipping manifest document."). Accordingly, it is respectfully submitted that there is a patentable difference between Claims 9 and 10, and between Claims 40 and 41, as those claims have been amended herewith.

SECTION 112

In the Office Action, the Examiner rejected Claims 1-21, 26-51, and 56-69 as being indefinite under 35 U.S.C. §112 on several grounds.

In the Office Action, the Examiner objected to the term "each of a plurality of users" in Claims 1, 32, and 62, as indefinite. Amendments to the rejected claims recite, e.g., "each respective user of a plurality of users."

In the Office Action, the Examiner objected to the term "each of said cells" in Claims 3 and 34, as indefinite. Amendments to the rejected claims recite, e.g., "each respective cell of said plurality of cells."

In the Office Action, the Examiner objected to the punctuation of Claims 4-6, 14, 19, 26, 28, 29, 30, 31, 35-37, 44, 49, 56, 58-61, and 64, and suggested additional punctuation. Amendments to the rejected claims incorporate additional punctuation.

In the Office Action, the Examiner objected to the term "said sub-cell divisions" in Claims 5 and 36 as having insufficient antecedent basis. Amendments to Claims 5 and 36 more distinctly recite antecedent basis for the claimed term.

In the Office Action, the Examiner objected to the term "each of the plurality of displayed delivery dates" in Claims 17 and 47 as indefinite. Amendments to the rejected claims recite "each displayed delivery date of the plurality of displayed delivery dates."

In the Office Action, the Examiner objected to Claims 21 and 51 on the grounds that it was unclear to the Examiner how the second axis could be associated with time and carrier name. Amendments to Claims 21 and 51 (renumbered as Claim 52) more distinctly claim the invention.

SECTION 101

In the Office Action, the Examiner rejected Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51, and 56 through 61 under 35 U.S.C. §101. In rejecting these claims under Section 101, the Examiner read the claims as "not require[ing] the use of the computer system" but as "mere[ly] recit[ing]" . . . "technological arts . . . in the preamble." The Examiner concluded that the preamble of the rejected claims provided a "mere implication of employing a machine or article of manufacture to perform some or all of the recited steps" and that the rejected claims are "directed to non-statutory subject matter."

It is respectfully submitted that because reference in the preamble of each of Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), to "a computer system" provides antecedent basis for subsequent reference to "*the* computer system" in each of Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), those claims are properly directed to statutory subject matter under Section 101. In particular, the preamble of each of Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), recites, or is dependent on a claim that recites, "a . . . computer system"; the body of the rejected claims (or a claim on which the subject claim is dependent) uses as antecedent basis, recitation of "a...computer system" in the preamble. For example, the preamble of Claim 1 recites "A . . . computer system"; the body of Claim 1 (as amended) recites . . . "wherein each respective user accesses *the* computer system . . . ". (Emphasis added).

It is respectfully submitted that the preamble of a claim, such as the preamble of Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), that recites matter that breathes life into the claim should not be discounted as a mere recitation of technological arts. See Stranco Inc. v.

Atlantes Chemical Systems Inc., 15 U.S.P.Q.2d 1704, 1713 (S.D. Tex. 1990) ("The fact that a preamble is necessary to provide antecedent basis for subsequent language in the claim is significant in determining that the preamble is a claim limitation."); see also, Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997) ("Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. . . ."). In the present case, because the preamble of Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), provides antecedent basis for subsequent language of the claims, the claim preamble of each respective claim is properly taken into account when interpreting each claim.

Taking the preamble of each respective claim into account, it is respectfully submitted that Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), are directed to statutory subject matter under 35 U.S.C. §101 because they are expressly directed to a computer system, or a method using a computer system, as the case may be.

Further, as the Examiner agrees, Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51, and 56 through 61 are directed to a practical application in the technological arts, the purpose of which is to produce a real world useful result, namely, e.g., "calculated rates for carriers used in selecting a specific service for shipping ...". Office Action, page 6, topic number 17. Therefore, Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), are directed to statutory subject matter under 35 U.S.C. §101. See, e.g., State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998) (citations omitted) ("Congress intended §101 to extend to 'anything under the sun that is made by man.'"); id. at 1372 ("The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e.,

those found in §§102, 103 and 112, P.2, n. 2."); MPEP §2106 II, A (the "purpose of this [section 101] requirement is to limit patent protection to inventions that possess a level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept."); *id.* ("[Patent] Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.").

Further, the claims rejected under section 101 have been amended to expressly recite that the claimed computer system comprises at least one computer device.

For the above reasons and authorities, it is respectfully submitted that Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), as amended, are directed to statutory subject matter under 35 U.S.C. §101; it is respectfully requested that Claims 1 through 7, 13 through 21, 26 through 38, 41 through 51 (renumbered as Claims 41 through 52), and 56 through 61 (renumbered as Claims 57 through 62), as amended, be reconsidered.

SECTION 103

In the Office Action, the Examiner rejected Claims 1, 2, 13, 14, 32, 33, 43, 44, 62, and 63 under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (6,233,568; "Kara") in view of UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com).

In rejecting these claims, the Examiner, with reference to Figure 8 of Kara, stated that: "Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services." Office Action, page 9, topic number 22. The Examiner conceded that "Kara does not specifically disclose the rates being calculated with respect to time. . . ." but , citing excerpts from an archive of www.ups.com and www.fedex.com, concluded

that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. . . ." and that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive 'urgency' services, as disclosed by FedEx® and UPS®" Office Action, page 9, topic number 22.

As distinguished from Kara, whether considered alone or in combination with the cited excerpted www.ups.com or www.fedex.com references, or with any other reference of record, the section-103-rejected claims of the present application, as amended, are directed to a simultaneous cross-comparison display of calculated shipping rates for each service of a plurality of services offered by each carrier of a plurality of carriers. As compared to displaying shipping rates for each service of a plurality of services offered by each carrier of a plurality of carriers, in Kara, the "program automatically calculates the [shipping] fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters." Kara, col. 22, lines 39 – 42. That is, the user in Kara must first indicate a type of service (e.g., Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day); once a user has indicated a type of service, Kara discloses then calculating the shipping rate for each carrier that supports the selected type of service; only one rate per carrier is calculated.

As distinguished from Kara, the present claimed invention is directed to displaying a simultaneous cross-comparison of calculated shipping rates for each service of a plurality of services for each carrier of a plurality of carriers. None of the cited references, alone or in combination, disclose or suggest displaying a simultaneous cross-comparison of calculated shipping rates for each service of a plurality of services for each carrier of a plurality of carriers. Indeed, the excerpted www.ups.com and www.fedex.com references cited by the Examiner do not disclose a simultaneous cross-comparison display of rates for the various services offered by those two respective carriers. Accordingly, it is respectfully submitted that none of Kara, or the cited excerpted www.ups.com or www.fedex.com references, whether considered alone or in combination with any

other reference of record, disclose, anticipate, or suggest the subject matter of the amended claims of the present application.

The Examiner rejected Claims 3-12, 15-20, 26-31, 34-42, 45-50, and 56-69 under 35 U.S.C. §103(a) as being unpatentable over Kara, UPS®, and FedEx® as applied to claims 1, 2, 32, 33 and 62 and further in view of Barnett, et al. (6,369,840; "Barnett"). According to the Examiner, Barnett discloses, in its Figure 9, a calendar with a graphical representation of date on one axis and time on another. The Examiner concludes that "[i]t would have been obvious to . . . display the calculation of shipping rates . . . in the format of a plurality of cells with date on one axis and time on another . . . in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time . . ." Office Action, page 10, topic number 24 (citing Barnett, col. 2).

With respect to the rejection of Claims 3-12, 15-20, 26-31, 34-42, 45-50 (renumbered as Claims 46-51), and 56-69 (renumbered as Claims 57-70), for the reasons given above, none of Kara, or the cited excerpted www.ups.com, or www.fedex.com references, whether considered alone or in combination with any other reference of record, disclose, anticipate, or suggest the subject matter of the amended claims of the present application.

Further, there was no citation provided by the Examiner to any reference as to any motivation for displaying calculated rates according to a graphical date/time matrix. Moreover, Barnett does not disclose or suggest calculating rates and displaying the calculated rates according to a graphical date/time matrix. Rather, Barnett discloses "provid[ing] a multi-layered calendaring system wherein events belonging to different categories and selected by a user can be overlaid on one another in a single integrated calendar." Barnett, col. 2, lines 26 – 29.

Further, it is respectfully submitted that, even if fees for events were displayed in the Barnett calendar depicted in Figure 9, those fees would be associated with the particular event calendared, not, as with the present claimed

invention, calculated according to shipping and parcel specifications for shipping a particular parcel.

For the foregoing reasons and authorities, because independent Claims 1, 13, 26-32, 43 (renumbered as Claim 44), 56-69 (renumbered as Claims 57-70) (as amended), are patentable over the cited references, Applicant respectfully submits that dependent Claims 2-12, 14-21, 33-42, and 44-51 (renumbered as Claims 45-52), are therefore also patentable over the cited references.

In view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully submits that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the amended application.

Respectfully submitted,

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